

IN THE
United States Court of Appeals
for the Ninth Circuit

R. A. HENDERSON,

Plaintiff - Appellant,

vs.

FORD MOTOR COMPANY,

Defendant - Appellee.

APPELLEE FORD MOTOR COMPANY'S BRIEF

FEB 14 1967

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JURISDICTION

The jurisdiction is correctly set forth in Appellant's Brief.

COUNTER-STATEMENT OF THE CASE

A. The Issue Of This Appeal

Defendant Ford Motor Company moved the Court for a Summary Judgment that Claim 6 of R. A. Henderson Patent No. 3,088,447 is invalid as being anticipated by U. S. Patent No. 2,354,373 issued July

25, 1944 to Lincoln Hanks under the provisions of 35 U.S.C. 102(b) :

“A person shall be entitled to a patent unless —
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.”

Defendant Ford Motor Company's Motion for Summary Judgment was not concerned with 35 U.S.C. 103 and accordingly none of the remarks directed to “obviousness” appearing in the BRIEF FOR APPELLANT are in any way applicable to the decision of the District Court in connection with this appeal.

B. Henderson Patent No. 3,088,447 In Suit

Referring to the reproductions of Figs. 1 and 2 of the Henderson patent reproduced at Appendix Page 1 to this brief, the Henderson device is adapted to conduct crankcase vapors and air pollutants from the crankcase 19 of an internal combustion engine to the intake manifold for intermixture with the fuel and air mixture from the carburetor for combustion in the cylinders in an effort to reduce harmful exhaust gas pollutants.

The Henderson device includes a pickup pipe 20 that extends from the engine crankcase 19 to an oil separator 18. The latter is connected to valve 16 by conduit 86. Valve 16 includes a slidable element 52 that is biased towards a closed position by a spring 62. From the valve 16 another pipe 44 extends to a plate-like adapter 10 that fits between the carburetor

12 and the intake manifold 14. This adapter includes grids or screens 28 and an electric resistant heating element 66 for heating the fuel and air mixture from the carburetor and the vapors from the engine crankcase 19. The adapter 10 is formed at one side with an inlet port 36 fitted with an adjustable needle valve 38 that controls flow through the pipe 16 into the adapter.

In the operation of the Henderson device, when the engine is running vapors from the engine crankcase pass through pickup pipe 20, oil separator 18, pipe 86, valve 16, pipe 44 and adapter inlet port 36 into the adapter. Control over the flow of such vapor is by means of the valve 16 and adjustment needle 38, with the extent of opening of valve 16 being determined by the magnitude of the intake manifold pressure. Crankcase vapors entering the adapter will be drawn into the intake manifold together with fuel vapor from the carburetor 12. The electric heating element 66 is said to vaporize the gases flowing through the adapter 10 so as to produce more efficient combustion thereof within the engine.

Claim 6 of the Henderson patent in suit which was held invalid by the District Court is set forth immediately herebelow in divisible parts.

(6) In combination with an internal combustion engine having a crankcase, a source of combustible mixture and an intake manifold to supply the mixture to the engine; means for reducing the air pollutant products of the engine, comprising:

an adapter mounted between said source of combustible mixture and said intake mani-

- fold and having an opening through which the combustible mixture passes;
- an inlet port in said opening;
- a pipe connecting said inlet port with said crankcase to conduct crankcase vapors into said opening;
- a flow control valve in said pipe operable by engine induced vacuum to control flow of crankcase vapors according to engine speed;
- and
- heating means in said adapter adjacent said opening.

C. Lincoln Hanks Patent No. 2,354,373

Referring to Figs. 1 and 3 of the Hanks patent reproduced at Appendix Page 2, the District Court held in Finding 8 that the disclosure of the Hanks patent and its structural relationship to Henderson Claim 6 is as follows:

United States Letters Patent No. 2,354,373 issued July 25, 1944 to Lincoln Hanks discloses an automobile engine fuel mixing device that includes a hollow spacer or mixing chamber 8 which is mounted between the carburetor 6 and the intake manifold of the engine. This mixing chamber 8 is formed with a central, vertical opening 22, 23 and 24 through which the combustible mixture from the carburetor passes downwardly into the intake manifold. This mixing chamber 8 therefore corresponds exactly to the element "an adapter mounted between said source of combustible mixture and said intake manifold and having an opening through which

the combustible mixture passes" recited in Henderson Claim 6. The mixing chamber 8 of Hanks is formed at its upper right-hand portion (Fig. 3) with an inlet port (not numbered) that receives a pipe length 39, with such inlet port of Hanks corresponding exactly to the "an inlet port in said opening" element of Henderson Claim 6. Hanks also includes pipe lengths 39 and 33 which connect the aforementioned inlet port with the engine crankcase to conduct crankcase vapors into the opening 22, 23 and 24 of the mixing chamber 8. Thus, pipe lengths 39 and 33 correspond exactly with "a pipe connecting said inlet port with said crankcase to conduct crankcase vapors into said opening" element of Henderson Claim 6. Interposed between the pipe lengths 39 and 33 of Hanks is a spring-biased valve 34 that is operable responsive to the intake manifold pressure of the engine so as to control flow of crankcase vapors through pipe lengths 39 and 33 into the opening 22, 23 and 24. This valve 34 of Hanks therefore corresponds exactly with the "a flow control valve in said pipe operable by engine induced vacuum to control flow of crankcase vapors according to engine speed" element of Henderson Claim 6. Finally, Hanks conducts exhaust gases from the engine through a pipe 19 into an outer heat exchange jacket defined by walls 31 of mixing chamber 8, such exhaust gases discharging through pipe 20. This arrangement effects heating of the mixing chamber walls 28 that define the midportion of the opening 22, 23 and 24 of Hanks' member 8. Accordingly, Hanks clearly discloses the "heating means in said adapter adjacent said opening" element of Henderson Claim 6.

It is not controverted that the Hanks patent was not cited by the Patent Office during the prosecution of the

Henderson patent in suit. This fact is set forth in Finding X.

D. How The Facts Were Brought To The Attention Of The District Court.

The teaching of the Henderson patent in suit and the disclosure of the Hanks patent and its relation to Claim 6 of the Henderson patent in suit were brought to the attention of the District Court by means of true copies of the Henderson and the Hanks patents, the AFFIDAVIT OF JOHN J. ROETHEL IN SUPPORT OF DEFENDANT FORD MOTOR COMPANY MOTION FOR SUMMARY JUDGMENT (TRANSCRIPT OF RECORD Page 78) and testimony adduced at the hearing on the Motions for Summary Judgment of both Ford Motor Company and General Motors Corporation November 8, 1965.

E. Appellant's Alleged Specification Of Error

And The Question Presented By This Appeal — As Set Forth In The Brief For Appellant.

Specification Of Error

The District Court erred in holding that the pleadings and testimony did not raise any genuine issue on any material fact.

Question Presented

Does the expediency of a dismissal summarily given outweigh the patent purpose of an important invention (smog control device) where the parties do not agree on facts pertinent to the alleged anticipation?

SUMMARY OF ARGUMENT

A. The Question Presented By This Appeal Has Previously Been Answered In The Affirmative By This Court.

B. The Presumption Of Patent Validity Relied Upon By Appellant Does Not Apply.

C. There Is No Presumption Against Summary Judgment Where There Are No Genuine Issues Of Fact.

D. The Facts Which Appellant Urges Require Consideration Have No Relevancy To Anticipation Of The Henderson Patent In Suit By The Prior Art Hanks Patent.

ARGUMENT

A. The Question Presented By This Appeal Has Previously Been Answered In The Affirmative By This Court.

Appellant herein questions whether or not it is proper in a patent infringement case to grant a Motion for Summary Judgment invalidating a patent for anticipation unless plaintiff and defendant agree on the facts pertaining to such anticipation. This question has already been answered in the affirmative by this Court in *Rankin et al v. King et al* decided November 12, 1959; 272 F. 2d 254.

In the *Rankin* case the District Court granted a Motion for Summary Judgment holding the patent there in suit invalid as lacking invention over a prior art patent. In opposing the motion, plaintiffs relied upon affidavits alleging questions of fact existed and affidavits differing in interpretation and reading of the prior art patent. Under those circumstances this Court held that the mere presence of such counter-affidavits were of no consequence if the Court chose not to consider such disputed facts in rendering the Motion for Summary Judgment and instead rendered its judgment as a matter of law from the undisputed facts disclosed by the patent in suit and the prior art patent. The *Rankin* case is substantially on all fours with the present case as indicated by the following language from *Rankin*:

“The mere presence of affidavits alleging questions of fact existed, or differing in interpretation and reading of the patent and various prior art, whether cited or non-cited, is of no consequence if the court did not consider such

disputed facts. Here he specifically declined to consider such affidavits, but considered only the patent in suit, the alleged infringing product, the prior art cited in the file wrapper, and the non-cited prior art. The authenticity of the various patents (Exhibits A to I, inclusive) and of the sole physical Exhibit (Exhibit L) were unquestioned.

Thus unless the court needed expert help in reading the patent, it appeared clearly as a matter of law from the undisputed facts disclosed by the letters and the file wrapper of patent No. 2,366,986 and the prior art patents both cited and non-cited, that the patent in suit was invalid because of want of patentable novelty.⁶ The motion for summary judgment was therefore properly granted.⁷

Appellants ask us to rule, relying on *Adams v. Columbus Manufacturing Co.*, M. D., Ga., 1958, 169 F. Supp. 346, 120 USPQ 75, that a summary judgment *cannot* be granted where affidavits contradictory in nature have been filed. This we cannot do. In *Adams*, *supra*, the trial court was asked to consider such affidavits. The court refused. It did not say it *could* not grant summary judgment, but that 'it must indeed be a rare patent case which can be thus summarily truncated.' The language of that case limits the rule to what the court should 'ordinarily' do. With that qualification we agree. And we will agree that it is 'usually inappropriate' to grant summary judgment in the ordinary patent case. *Baker v. First Nat. Stores*, D. Mass., 1946, 64 F. Supp. 979, 980, 69 USPQ 11, 12."

Applying the above set-forth language to the facts in the present case, appellant herein seeks to create genuine issues of material fact solely by means of contradictory

testimony adduced by Messrs. Henderson and Neil at the hearing of November 8, 1965 on the Motions for Summary Judgment. Under the rationale of the *Rankin* case the District Court in the present case was not obliged to consider such testimony if it appeared as a matter of law from undisputed facts disclosed by the Henderson patent in suit and the prior art Hanks patent that the Henderson patent is invalid. The Findings made by the District Court herein clearly demonstrate that the undisputed facts disclosed by the Henderson and Hanks patents led the District Court to conclude the Henderson patent to be invalid as anticipated by the Hanks patent. Hence it was not necessary for the District Court to consider any so-called disputed facts presented by appellant. The question presented by this appeal should therefor be answered in the affirmative here just as it was in the *Rankin* case.

The question raised by appellant herein was also answered in the affirmative by the Fifth Circuit Court of Appeals in *Ronel Corp. v. Anchor Lock* decided December 20, 1963; 325 F. 2d 889. In the *Ronel* case the defendant filed a Motion for Summary Judgment supported by an Affidavit of a patent attorney establishing anticipation of the patent in suit by a prior art patent. Plaintiff filed several counter-affidavits and upon the District Court granting defendant's Motion for Summary Judgment appellant appealed contending that there were genuine issues of fact requiring a full trial. The Fifth Circuit Court of Appeals affirmed the District Court holding:

“It is apparent to us that the trial court could, by observation of the two devices, readily arrive at the conclusion reached by it. The court could

not be aided by the affidavits of any number of experts pro or con in reaching this conclusion. This, therefore, presented such a situation as was under consideration by the Court of Appeals for the Sixth Circuit in the Bobertz case, *supra*, in which the Court said, 107 USPQ at 342:

“Where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under rule 56 is proper.”

The question of appellant Henderson herein has also been answered in the affirmative by the Seventh Circuit Court of Appeals in *A.R. Inc. v. Electro-Voice, Inc.* decided December 28, 1962; 311 F. 2d 508. In the *A.R.* case the defendant attempted to raise a genuine issue of fact by means of deposition and affidavits. The Seventh Circuit Court of Appeals upheld the District Court's granting of the motion and the following language from the decision is particularly in point with respect to the case at issue here:

“The issue presented by the defendant's motion for summary judgment, and resolved favorably to the defendant by the District Court, is whether the plaintiff's patent is valid over the prior art. It concerns, as above indicated, the showing made by the prior art before Villchur produced his alleged invention, the nature of the improvement the patentee has made over the prior art, and the final step of resolving whether the difference over the prior art disclosures is properly classifiable as ‘invention.’ *Armour & Co. v. Wilson & Co., Inc.*, 7 Cir., 274 F.2d 143, 156, 124 USPQ 115, 125. The prior art relied upon here is documentary in form. It did not stand mute but spoke for itself. *Armour & Co. v. Wilson & Co.*, *supra*. And, we do not find anything in

the deposition testimony of Villehur or his affidavit, accepting it as we do as the testimony of a qualified expert in the field, which precipitates a genuine factual issue material to the resolution of the ultimate issue presented by defendant's motion. The situation here is analogous to that presented in *Davison Chemical Corp. v. Joliet Chemicals, Inc.*, 7 Cir., 179 F2d 793 84 USPQ 325, in which this court recognized that a suit concerning the validity of a patent over the prior art is not immune from disposition on motion for summary judgment even though, in addition to prior art patents, deposition testimony of the applicant and affidavits are involved, if no genuine issue of material fact is present. And see: *Magee v. Coca-Cola Company*, 7 Cir., 232 F. 2d 596, 109 USPQ 124."

The Sixth Circuit Court of Appeals has also answered the question of appellant Henderson herein in the affirmative. This Court's attention is respectfully directed to *Deering Milliken Research Corp. v. Electric Furnace Corp.* decided December 15, 1958; 261 F. 2d 619. In the *Deering* case the Sixth Circuit Court of Appeals disposed of the question presented in the following language:

"The appellant urges that the issuance of a patent put a heavy burden of proof upon one who challenges its validity and evidence that the alleged invention filled a long-felt want is *prima facie* evidence of invention, therefore, the District Court should have had the benefit of all of the evidence which the appellant could produce to support the presumption of validity. Such evidence, it recites, would include expert testimony interpreting the technical publications, evidence as to the state of the art and the duration of the problem's existence. With this evidence before it, the District Court would be in a position to render a decision

based upon the merits. The argument does not fit the present case. The specification of the patent fully discloses prior art and the specific nature of the improvements claimed. The publications relied upon by the appellee speak for themselves and no expert testimony can change their disclosure.”

It will therefore be seen that the question presented by the appeal herein has already been answered in the affirmative in the Ninth, Seventh, Sixth and Fifth Circuits. The appellant herein has failed to set forth any cogent reasons as to why the question should be answered in the negative in this case. The patent in suit and the prior art Hanks patent are both easily understandable by a court without the aid of expert testimony. Under these circumstances it was not necessary for the District Court to have before it any other facts than those disclosed by the Henderson and Hanks patents in order to rule as a matter of law that the Hanks patent anticipates Claim 6 of the Henderson patent in suit. Accordingly, it is clear that there is sufficient evidence sustaining the findings of the District Court herein to preclude such findings from being held “clearly erroneous” under F.R.C.P. 52 (a).

B. The Presumption Of Patent Validity Relied Upon By Appellant Does Not Apply.

In the Summary of Argument of Appellant’s Brief herein it is urged that the patent in suit should be presumed valid. It has been consistently held in the Ninth Circuit, however, that the usual presumption of validity which attaches to a patent is dissipated when the most pertinent prior art was not cited by the Patent Office.

This rule has been set forth in many cases including the recent case of *Monroe Auto Equipment Co. v. Superior Industries, Inc.* (May 1964) 332 F. 2d 473, Cert. Den. 379 U.S. 901, wherein the Court held:

“The existence of but one pertinent example of unconsidered prior art is not only sufficient basis to dissipate the presumption of validity (*Pressteel Co. v. Halo Lighting Products Inc. Supra*; *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp. Supra*), but may render the patent invalid.”

The Ninth Circuit *Pressteel* case is cited at 314 F. 2d 695 while the Ninth Circuit *Jaybee* case is cited at 287 F. 2d 228. Another Ninth Circuit case in point is *Jacuzzi Bros. v. Berkeley Pump Co.* 191 F. 2d 632.

Applying the law of the above cases to the facts of this case, the Hanks patent is not listed at the end of the Henderson patent in suit and accordingly the Hanks patent was not considered by the Patent Office during the prosecution of the patent in suit. Accordingly, the presumption of validity normally attaching to a patent is dissipated in this case, and this fact is set forth as Finding X made by the District Court.

C. There Is No Presumption Against Summary Judgment Where There Are No Genuine Issues Of Fact.

In the Summary of Argument of Appellant's Brief herein it is urged that there is a presumption against a summary judgment. This presumption, however, does not apply where there are no genuine issues of fact as in the present case. The Ninth Circuit has frequently granted motions for summary judgment in cases such as the present where there are no genuine issues of fact.

Recent decisions of this nature are *Englehard Industries v. Research Instruments* 324 F. 2d 347, cert. den. 377 U.S. 923, and *Oregon Saw Chain Co. v. McCulloch*, 323 F. 2d 758.

The following quotation by this Court in *Barkeij v. Lockheed* 210 F. 2d 1 is believed to be particularly in point:

“it is the duty of the Court to dismiss a patent infringement case whenever it affirmatively appears that the patent is invalid. (Citing cases.) If it affirmatively appears on a motion for summary judgment that the patent is invalid, the duty to dismiss is as compelling as it would be after hearing evidence.”

D. The Facts Which Appellant Urges Require Consideration Have No Relevancy To Anticipation Of The Henderson Patent In Suit By The Prior Art Hanks Patent.

Appellant urges that a multitude of matters of evidence must be considered on the issue of degree of similarity of the prior art. Such matters, however, have no relevancy to anticipation of the patent in suit by the prior art Hanks patent.

The recent Supreme Court decision in *Graham v. John Deere* cited in Appellant's Brief points out that 35 USC 102 expresses the “new and useful” tests of patentability while 35 USC 103 expresses the non-obvious” test of patentability. Further, that it is only in connection with the “non-obviousness” test that the factual criteria of the type set forth by appellant herein may have relevancy. The following language expresses this rationale:

“While the ultimate question of patent validity is one of law, *A & P Tea Co. v. Supermarket Corp.*, supra, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or non-obviousness, these inquiries may have relevancy.”

35 USC 102(b) requires that an invention be “novel” in order to be patentable. If the alleged invention has been patented by another more than one year prior to the date of the patent application therefor, the resulting patent is invalid. Under this test, the existence or nonexistence of the matters of evidence set forth by appellant herein is completely irrelevant and immaterial. The question as to whether or not the prior art Hanks patent discloses the same subject matter that is recited in Claim 6 of the Henderson patent can be easily decided by a mere comparison of the disclosures of the two patents.

CONCLUSION

It is appellant's position as indicated by the question presented by his Brief that a motion for summary judgment can never be granted where the plaintiff and defendant do not agree on the facts pertinent to the grounds for such summary judgment. If appellant's position is sound, a party could preclude the granting of summary judgment by simply producing groundless counter-affidavits or other evidence traversing the evidence advanced by the moving party. The appellant's position is obviously unsound and at odds with both law and reason. The appellant herein relies upon the same arguments as the appellant in the *Rankin* case discussed hereinbefore. These arguments are no more valid in this case than in the Rankin case.

All of the facts necessary to hold the Henderson patent in suit invalid were before the District Court. No other facts were needed. Under these circumstances it would be a waste of time and effort to require a full trial.

The Henderson patent in suit is fully anticipated by the prior art Hanks patent and thus invalid under the provisions of 35 USC 102 (b).

The usual presumption of validity relied upon by appellant does not apply because the Hanks patent was not cited by the Patent Office.

The judgment of the District Court should be affirmed.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

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APPENDIX

Appendix 1

May 7, 1963

R. A. HENDERSON

3,088,447

CONTROL FOR AUTOMOTIVE EXHAUST AIR POLLUTION

Filed Dec. 5, 1961

4 Sheets-Sheet 1

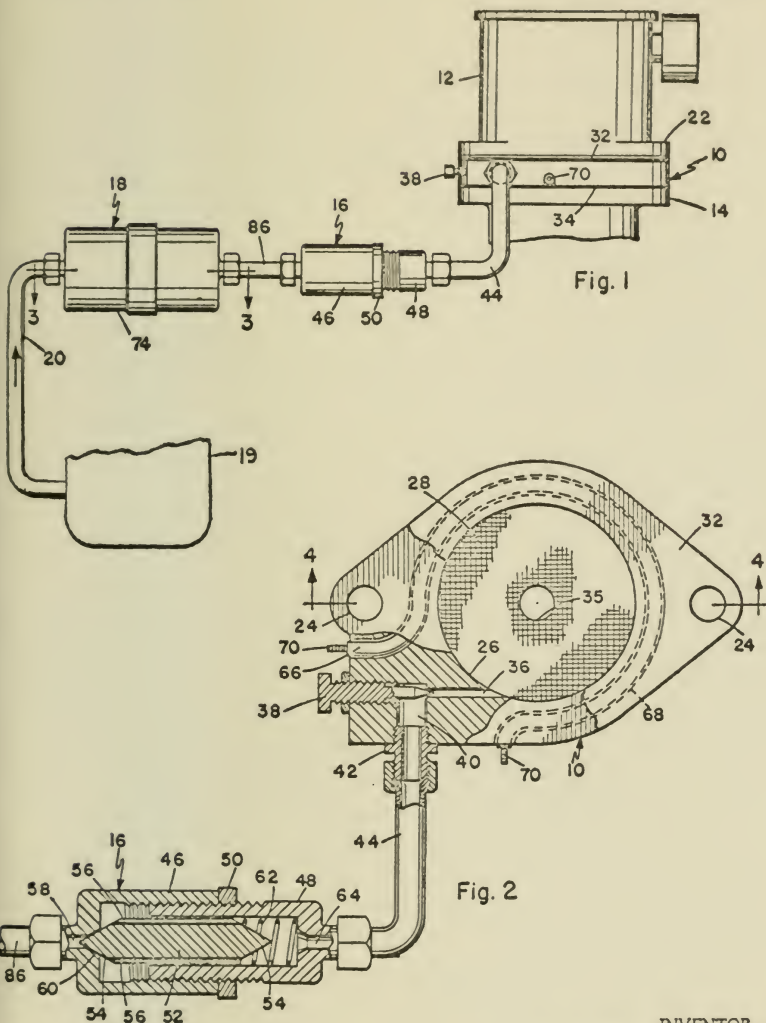


Fig. 2

INVENTOR
RAY A. HENDERSON

BY

Knox & Knox

Appendix 2

July 25, 1944.

L. HANKS

2,354,373

SUBCARBURETOR

Filed Feb. 3, 1943

2 Sheets-Sheet 1

